

SEP 22 2005

Customer No. 33647

Patent
Attorney Docket No. ITW7510.074

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Stein et al.
Serial No. : 10/605,546
Filed : October 7, 2003
For : Method and Apparatus to Adaptively Cool
A Welding-Type System
Group Art No. : 1725
Examiner : Kerns, K.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

Mailing

☐ deposited with the US Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 CFR 1.8(a)

37 CFR 1.10

☐ with sufficient postage as first class mail. ☐ As "Express Mail Post (Office to Addressee)" Mailing Label No.

Transmission

☒ transmitted by facsimile to Fax No.: 571-273-8300 addressed to Office Of Petitions at the Patent and Trademark Office.

Date: 9/22/05

Jessica A. Calaway
Signature

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO THE DIRECTOR UNDER 35 C.F.R. 81.181 FOR REVIEW OF
PREMATURE FINALITY**

Dear Ms. Lee:

Responsive to the Final Office Action mailed July 19, 2005, please consider the following remarks requesting that the finality of the Office Action of July 19, 2005 be withdrawn as premature.

Stein et al.

S/N: 10/605,546

REMARKS

Claims 1-23 are pending in the present application and have been finally rejected as anticipated by Prunier (FR 2,536,320). In the first Office Action mailed March 22, 2005, the Examiner rejected claims 1-23 under 35 U.S.C. §102(b) as being anticipated by Prunier (FR 2,536,320). In setting forth the rejection, the Examiner reproduced the elements of the claims and cited to the abstract, the French text of the specification and claims; and the Figure as supporting the rejection of the claims as anticipated by Prunier (FR 2,536,320). The Examiner did not provide a translation of the French text of the specification and claims of the foreign reference in the Office Action of March 22, 2005. In the Response of May 16, 2005, Petitioner requested that, in accordance with MPEP §706.02.II, the Examiner provide an English translation of the document rather than relying on the French text thereof. Subsequent thereto, in the Office Action of July 19, 2005, the Examiner provided the English translation of the French text and rejected the claims as anticipated by the English translation of the French text of Prunier (FR 2,536,320). The Examiner made the rejection of claims 1-23 as anticipated by the English translation of the French text of Prunier (FR 2,536,320) final in the Office Action of July 19, 2005 – the Action which, for the first time, presented the English translation of the French text of Prunier (FR 2,536,320).

Petitioner requested reconsideration and sought to resolve the premature finality of the Office Action of July 19, 2005 with the Examiner and later with the Examiner's supervisor. Applicant left a telephone message with the Examiner on August 2, 2005. The Examiner left a telephone message at the office of the undersigned on August 3, 2005 and therein refused to withdraw the finality of the Office Action. The Examiner further explained that his supervisor was unavailable. Petitioner was able to contact Supervisory Patent Examiner Tom Dunn on September 19, 2005 and discussed at length the finality of the outstanding Action. Mr. Dunn was also unwilling to withdraw to finality of the outstanding action. Both the Examiner and the SPE maintained that a rejection based, in whole or in part, on a document printed in a non-English language can be made final in a subsequent action with the first presentation of the translation. Petitioner respectfully disagrees that such a position is authorized or supported by the MPEP.

MPEP §706.07 states that "[b]efore a final action is in order, a clear issue should be developed between the examiner and applicant." MPEP §2271 also states that "[t]o bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made

Stein et al.

S/N: 10/605,546

final.” (Emphasis added). MPEP §706.07 further states that “present practice does not sanction hasty and ill-considered final rejections” and “[t]he applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.”

In setting forth the first rejection of the present claims over Prunier (FR 2,536,320), the Examiner relied on, at least in part, the underlying French text of Prunier (FR 2,536,320). The Examiner stated that he “know[s] a few French terms” and that the original rejection of the claims relied, at least in part, on the Examiner’s translation of these “few French terms”. This particular Examiner’s linguistic abilities aside, the Office Action cannot rely on such an informal “reading” of a reference. Such does not make for a very reliable record. Albeit that this Examiner may know a “few French terms,” would not provide an applicant with “such information ... as may be useful in defining the position of the Office as to unpatentability” as is required by MPEP §2271. An applicant simply cannot determine the propriety of the rejection until an English translation of the underlying foreign document has been provided.

The Examiner maintains that it is an Applicant’s responsibility to acquire a translation of the underlying foreign language document if interpretation thereof is desired before the Action is made final. MPEP §2271 is clear that “the examiner will twice provide the patent owner with such **information and references** as may be useful in defining the position of the Office as to unpatentability before the action is made final.” (Emphasis added). MPEP §2271 does not merely require the Office to provide the reference used to support a rejection, MPEP §2271 requires the Examiner to also provide the information used to support the rejection. Providing the French Text, or any text that is not in English, relied upon to reject the claims does not provide the information used to define the Office’s position. Minimally, the Examiner relied on the “few French terms” that he recognized therein. Recognizing a “few terms” completely removes those terms from the context of the underlying document. The Examiner never indicated or communicated what “few French terms” he understood from the underlying French text. Nonetheless, premising a rejection on “a few French terms” from an underlying French document removes those terms from their context and does not provide an applicant the requisite information required to determine the Office’s application of the foreign reference. MPEP §706.02.II recognizes and addresses such an inadequacy when dealing with Foreign references.

MPEP §706.02.II states that “[i]f the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is

Stein et al.

S/N: 10/605,546

clear as to the precise facts the examiner is relying upon in support of the rejection.” The SPE has asserted that this requirement does not prevent the Office from providing the translation in a subsequent final action even where the initial rejection is based, at least in part, on the foreign language text of the underlying foreign document. Such an interpretation directly contradicts the requirement of MPEP §2271 that the examiner will twice provide the patent owner with, not only the reference, but also the information – i.e. the English translation thereof -- that may be useful in defining the position of the Office.

MPEP §706.02.II further states that “[i]t is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best”, and that “[t]he converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection”, and that “[a]n abstract can have a different effective publication date than the full text document.” Simply, rejections based solely on the translated abstract of a foreign document are generally improper due to inconsistencies between the text of the translated abstract and the full-text of the underlying document and inconsistencies in the publication dates of the translated abstract and the underlying document. Relying on ‘a few terms’ from the underlying foreign language document does not resolve the first recognized inconsistency which may exist between the disclosure of the translated abstract and the disclosure of the full-text of the foreign language underlying document. Nonetheless, in accordance with MPEP §706.02.II, if the Examiner maintains a rejection based solely on the abstract and without reliance on the underlying full text document, in these limited circumstances, the Examiner can provide a translation in a subsequent action. That is not what has transpired in the above-captioned matter. See MPEP §706.02.II.

MPEP §706.02.II states that, “[w]hen both the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection” and that “[i]n **limited circumstances**, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the **abstract only without relying on the full text document**.” That is, without a translation, supporting a rejection through reliance on the full-text of the underlying foreign language document is improper. MPEP §706.02.II further states that, where the Examiner has proffered a rejection based only on the abstract and without reliance on the full text of the document, “in such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action.” MPEP §706.02 II only allows the sending of a translated document after a non-final office action has been mailed where

Stein et al.

S/N: 10/605,546

the Examiner has merely relied on the abstract, without relying on the full-text document. Only in those limited circumstances can the next office action be made final. Such an interpretation is consistent with MPEP §2271. That is, when a rejection is based only on the translated abstract, the Examiner has twice provided the information. A rejection based on the non-English full-text of a foreign document without a translation thereof, does not provide an applicant the information required to ascertain the appropriateness of the Office's position.

Accordingly, Petitioner respectfully requests withdrawal of the finality of the July 19, 2005 Office Action. In the Office Action of March 22, 2005, the Examiner rejected the present claims as anticipated by a foreign reference and relied, at least in part, on the foreign language full-text of the underlying document without providing a translation thereof. Such action does not include the information required to be provided by the Office by MPEP §2271. Applicant must be given a fair opportunity to respond. Providing a foreign language document does not provide such a fair opportunity. Accordingly, the subsequent Final Office Action of July 19, 2005 cannot be made final even if it includes an initial presentation of the translation of the foreign document as Petitioner has not been twice provided with the information and references required to determine the propriety of the Office's action as required under MPEP §2271. In accordance with MPEP §§706.02.II, 706.07, and 2271, the finality of the Office Action of July 19, 2005 is clearly premature. The assertion that a subsequent action which, for the first time presents the translation of the underlying foreign document used to reject the claims, can be made final is not supported by the MPEP. Accordingly, Petitioner requests that the finality of the July 19, 2005 Office Action be withdrawn as premature and further, that any subsequent action be non-final to afford Petitioner an opportunity to develop a clear issue with the Examiner with respect to the claims as included in the Response of September 22, 2005.

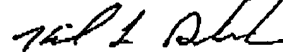
Stein et al.

S/N: 10/605,546

Petitioner hereby authorizes the Office to charge Deposit Account No. 502623 for any fees associated with entry and consideration of this Petition.

Petitioner appreciates the Director's consideration of these Remarks and cordially invites the Director to call the undersigned, should the Director desire any further clarification.

Respectfully submitted,



Kirk L. Deheck
Registration No. 55,782
Direct Dial 262-376-5170 ext. 16
kld@zpspatents.com

Dated: September 22, 2005
Attorney Docket No.: ITW7510.074

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170